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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,077	01/31/2001	Eric G. Lang	MS#150410.1/40062.85US01	8009
7590	07/01/2005			EXAMINER
Homer L. Knearl Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903				CHUONG, TRUC T
			ART UNIT	PAPER NUMBER
				2179

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/775,077	LANG, ERIC G.	
	Examiner Truc T Chuong	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 March 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13, 15-32 and 34-42 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13, 15-32 and 34-42 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                               |                                                                             |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                              | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/22/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                               | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

This communication is responsive to Amendment, filed 03/21/05.

Claims 1-13, 15-32, and 34-42 are pending in this communication, claims 1, 11, 26, and 28-29 are amended. This is made final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

***Claim Rejections - 35 USC § 102***

1. Claims 1-3, 6-8, 17-18, 22-23, 25-26, 28-29, 35-36, 38, and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanaswami (U.S. Patent No. 6,556,222 B1).

As to claims 1, 23, and 36, Narayanaswami teaches a user interface suitable for a small computing device, the user interface comprising:

a display screen (a user interface, e.g., col. 3 lines 1-16, and fig. 8A);  
a bezel encircling said display screen (bezel, e.g., col. 5 lines 60-67, and figs. 4, 8A-B),  
said bezel movable relative to said display screen (elements 310 and 312 of fig. 4 are selected/moved horizontally, and elements 314 and 316 are selected/moved vertically, and the bezel 400 is moving parallel on the top of an annular plate 420 of fig. 6B when turning the bezel for selections); and

a cursor displayed within said display screen, wherein said cursor is responsive to movement of said bezel (display cursor scrolling function for text and graphics, e.g., col. 3 lines 5-15, and col. 5 lines 43-46).

As to claim 2, Narayanaswami teaches the user interface wherein said cursor includes a pointing icon cursor (e.g., col. 5 lines 40-47).

As to claim 3, Narayanaswami teaches the user interface wherein said cursor includes a highlighted selection cursor (selecting a cursor highlighted icon, e.g., col. 9 lines 1-25, and fig. 7).

As to claim 6, Narayanaswami teaches the user interface wherein said bezel includes bezel buttons (e.g., col. 5 lines 25-60).

As to claim 7, Narayanaswami teaches the user interface wherein said bezel includes at least one touch sensor, said touch sensor operative to virtually move said bezel in response to finger contact without actually moving said bezel (touch sensitive screen panel, e.g., col. 5 lines 35-55).

As to claim 8, Narayanaswami teaches the user interface further comprising:

a display surface on said display screen (a user interface, e.g., col. 3 lines 1-16, and fig. 8A); and

wherein said bezel is rotatable about an axis, said axis being normal to said display surface (e.g., col. 5 lines 25-60, and figs. 8A-B).

As to claims 11 and 31, Nagayanaswami teaches the user interface further comprising:  
a display surface on said display screen (e.g., figs. 7-8B); and  
wherein said bezel is pivotable about a pivot point, said pivot point located on an axis normal to said display surface (the center of the clock, e.g., fig. 8A-B).

As to claim 17, Nagayanaswami teaches the user interface further comprising at least one movement sensor configured to provide a movement signal when movement of said bezel occurs (the wheel generates a signal as a mouse device would when rolled, e.g., col. 5 lines 39-65).

As to claim 18, Nagayanaswami teaches the user interface wherein said movement sensor is a micro-switch (the wheel generates a signal as a mouse device would when rolled, e.g., col. 5 lines 39-65).

As to claims 22 and 25, Nagayanaswami teaches the user interface wherein said bezel includes at least one touch sensor responsive to finger contact (touch sensitive screen panel, e.g., col. 5 lines 35-55).

As to claim 26, this is the equivalent method claim of system claim 1 and rejected under a similar rationale.

As to claim 28, Nagayanaswami teaches a portable Internet device, the device comprising:

- a display screen displaying Internet data (Internet text data, col. 7 lines 18-30);
- a bezel encircling said display screen (bezel, col. 5 lines 60-67, and figs. 4, 8A-B), said bezel movable relative to said display screen (elements 310 and 312 of fig. 4 are selected/moved horizontally, and elements 314 and 316 are selected/moved vertically); and

- at least one movement sensor configured to provide a movement signal when movement of said bezel occurs (display cursor scrolling function for text and graphics, e.g., col. 3 lines 5-15, col. 5 lines 35-60, and col. 5 lines 43-46).

As to claim 29, this is a combination of claims 1 and 11. Note the rejections of claim 1 and 11 above.

As to claims 35 and 40, Nagayanaswami teaches the user interface, wherein said bezel is moveable to a combination of rotated, pivoted, and planar positions (it can be rejected under similar rationale as claim 1 above).

As to claim 38, Nagayanaswami teaches the user interface wherein said bezel is rotatable about a center axis, said center axis being normal to said display surface and passing through a center point on said display screen (e.g., col. 5 lines 35-60, and figs. 7, 8A-B).

As to claims 41-42, Nagayanaswami teaches the user interface further comprising:

a display surface on said display screen, said bezel being movable along a plane substantially parallel to said display surface (elements 310 and 312 of fig. 4 are selected/moved horizontally, and elements 314 and 316 are selected/moved vertically, and the bezel 400 is moving parallel on the top of an annular plate 420 of fig. 6B when turning the bezel for selections).

#### *Claim Rejections - 35 USC § 103*

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. Patent No. 6,556,222 B1) in view of Moon et al. (U.S. Patent No. 6,433,801).

As to claim 4, Narayanaswami fails to teach a cursor including scrollbar cursor. Moon clearly teaches a cursor including scrollbar cursor (fig. 3, #132). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the cursor including the scrollbar cursor taught by Moon with the smart watch disclosed by Narayanaswami to enable the user to view textual data that is otherwise inaccessible due to the limited space of the display device.

3. Claims 5, 9-10, 12-13, 15-16, 30, 32, 34, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (US 6,525,997) in view of Rosenberg et al (US 6,219,032).

As to claim 5, Narayanaswami fails to teach a cursor including a text-selection cursor. Rosenberg teaches a cursor including a text-selection cursor (fig. 21). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the cursor including a text-selection cursor taught by Rosenberg with the smart watch disclosed by Narayanaswami to enable the user to select textual data displayed in a list.

As to claim 9, Narayanaswami teaches a bezel (see the rejection of claim 1 above); however, Narayanaswami fails to teach biasing to a non-rotated position. Rosenberg clearly teaches of biasing to a non-rotated position (fig. 20c; col. 57, lines 40 - 60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine biasing to a non-rotated position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the home position.

As to claim 10, Narayanaswami fails to teach a spring-like bezel for biasing said bezel to said non-rotated position. Rosenberg teaches a biasing said settings to said non-rotated position (fig. 20c; col. 57, lines 40 - 60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine spring-like coupling of said cursor to the non-rotated position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the said non-rotated position.

As to claims 12, 30 and 39, Narayanaswami fails to teach biasing to a non-pivoted position. Rosenberg clearly teaches biasing to a non-pivoted position (fig. 20c; col. 57, lines 40

60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine biasing to a non-pivoted position to the non-rotated position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the said non-rotated position.

As to claim 13, Narayanaswami teaches a bezel being a pivotal about a pivot point (see the rejection of claim 1 above); however, Narayanaswami fails to teach a spring-like bezel for biasing said bezel to said non-rotated position. Rosenberg teaches a spring coupled with the bezel biasing to said non-pivoted position (fig. 20c; col. 57, lines 40 - 60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine spring-like coupling of said cursor to the non- pivoted position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the said non- pivoted position.

As to claim 15, Narayanaswami teaches a bezel being a pivotal about a pivot point (see the rejection of claim 1 above); however, Narayanaswami fails to teach biasing to the rest position. Rosenberg teaches biasing to the rest position (fig. 20c; col. 57, lines 40 - 60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine biasing to the rest position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the home position.

As to claim 16, Narayanaswami teaches a bezel being a pivotal about a pivot point (see the rejection of claim 1 above). Rosenberg teaches a spring-like coupling with biasing to the rest position (fig. 20c; col. 57, lines 40 - 60); however, Narayanaswami fails to teach a spring-like bezel for biasing said bezel to said non-rotated pivoted position. Rosenberg teaches a biasing

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said settings to said non-rotated position (fig. 20c; col. 57, lines 40 - 60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine spring-like coupling of said cursor to the non-rotated or original position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the said non-rotated position.

As to claim 32, Narayanaswami teaches a bezel being movable along a plane substantially parallel to said surface (see the rejection of claim 1 above), and Narayanaswami teaches a bezel being moved along a plane (col. 5 lines 35-60); however, Narayanaswami fails to teach a spring-like bezel for biasing said bezel to said non-rotated pivoted position. Rosenberg teaches a biasing said settings to said nonrotated position (fig. 20c; col. 57, lines 40 - 600). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine spring-like coupling of the said cursor to the non-rotated or original position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the said non-rotated position.

As to claims 27, 34, and 37, Narayanaswami teaches said bezel (see the rejection of claim 1 above); however, Narayanaswami fails to teach biasing to a substantially centered position. Rosenberg teaches a biasing said settings to said non-rotated position or centered position (fig. 20c; col. 57, lines 40 - 60). This biasing demonstrates biasing to a "substantially" centered position. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine biasing to a substantially centered position taught by Rosenberg with the smart watch disclosed by Narayanaswami to provide a method for automatically resetting the bezel to the said non-rotated "centered" position.

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4. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. Patent No. 6,556,222 B1) in view of Hunt (U.S. Patent No. 6,029,122).

As to claim 19, Narayanaswami fails to teach a movement sensor being an optical encoder. Hunt clearly teaches a movement sensor being an optical encoder (col. 3, lines 3 - 11). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine a movement sensor being an optical encoder taught by Hunt with the smart watch disclosed by Narayanaswami to provide a method for entering input without making physical contact with the computing device.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. Patent No. 6,556,222 B1) in view of Curchod (U.S. Patent No. 5,826,578).

As to claim 20, Narayanaswami fails to teach a movement sensor being a magnetic encoder. Curchod clearly teaches movement sensor being a magnetic encoder (col. 4, lines 1 - 15). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the movement sensor being a magnetic encoder taught by Curchod with the smart watch disclosed by Narayanaswami to provide a method for entering data from magnetic mediums into the smart watch.

6. Claims 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. Patent No. 6,556,222 B1) in view of DeLine et al. (U.S. Patent No. 6,420,975).

As to claim 21, Narayanaswami fails to teach cursor being responsive to movement of said bezel in combination with spoken commands. DeLine teaches said cursor being responsive to movement of said bezel in combination with spoken commands (col. 49, lines 20 - 28). It

would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the cursor being responsive to movement of said bezel in combination with spoken commands taught by DeLine with the smart watch disclosed by Narayanaswami to provide a method for entering data with neither physical contact nor physical movement of the hands.

As to claim 24, Narayanaswami fails to teach cursor being responsive to movement of said bezel in combination with spoken commands. DeLine teaches said cursor being responsive to movement of said the bezel in combination with spoken commands (col. 49, lines 20 - 28). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the cursor being responsive to movement of said bezel in combination with spoken commands taught by DeLine with the smart watch disclosed by Narayanaswami to provide a method for entering data with neither physical contact nor physical movement of the hands.

### ***Response to Arguments***

7. The Declaration filed on 03/21/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the applied references.

a. Applicant seeks to establish prior invention by showing reduction to practice before June 30, 2000, the date of the Narayanaswami's reference.

#### **Reduction to Practice:**

b. In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. (*See MPEP 715.07*)

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a

commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985). (*See MPEP 2138.05*).

c. Applicant relies on Exhibit B to show reduction to practice; however, Exhibit B is merely a description of the concept of the invention.

d. A written description does not constitute an actual reduction to practice.

Furthermore, only the filing of a US patent application which complied with the disclosure requirement of 35 USC 112 constitutes a constructive reduction to practice. A written description, no matter how complete, which has not been made the subject of a US patent application does not qualify as reduction to practice.

e. Furthermore, the reduction to practice which must be shown is reduction to practice of the claimed invention. As already explained in the previous action, Exhibit B does not show the claimed invention. For example, a display screen, a cursor, or Internet data are not described in Exhibit B.

f. There is not enough evidence to clearly prove the relationships between Exhibit B and the claims. The new submitted Exhibit C and D do not belong to the applicant. It is “CASIO” watch. Moreover, Exhibit C and D show a “CASIO” watch which is NOT similar functions as the “Smart Watch” claimed by the applicant. Therefore, no reduction to practice has been shown and applicant has failed to establish prior invention.

Applicant's arguments of the Declaration filed on March 21, 2005 under 37 CRF 1.131 have been fully considered but they are not persuasive, and the rejection is still remained.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

06/09/05

BA HUYNH  
PRIMARY EXAMINER